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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/831,320	05/07/2001	Walter Gunter	GUNTER-2 (PCT)	2828
25889 7590 04/06/2009 COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576				
EXAMINER				
CHANG, VICTOR S				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
04/06/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

09/831,320

**Applicant(s)**

GUNTER, WALTER

**Examiner**

VICTOR S. CHANG

**Art Unit**

1794

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008 and 17 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 27-29 and 31-37 is/are pending in the application.
- 4a) Of the above claim(s) 27-29 and 31-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

## **DETAILED ACTION**

### ***Introduction***

1. Applicant's amendments and remarks filed on 10/22/2008 have previously been entered. Claims 27-29 and 31-37 are pending.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Grounds of rejections not maintained are withdrawn.

### ***Election/Restrictions***

4. Applicant's election with traverse of Species B.b. (four layer composite) and Species C of the process species set forth in claim 37 in the reply filed on 2/17/2009 is acknowledged. The traversal is on the ground(s) that

"It is believed that any search for the five layer composite species and related composition and/or process species would necessarily include a search for the four layer composite species and related composition and/or process species....  
In addition, it is believed that the objectives of streamlined examination and compact prosecution would be promoted if a search were conducted simultaneously for all of the species. Also, the necessity of filing multiple patent applications for the same invention does not serve to promote the public interest."

This is not found persuasive because a five-layer composite is clearly distinct from the elected Species of a four layer composite, and there is no evidence or any reason whatsoever to believe the additional layer is necessarily encompassed by the search of a four layer composite. Additional search for a patentably distinct composite is deemed to be burdensome to the

examiner. The requirement is still deemed proper and is therefore made FINAL. In summary, claim 37 is active. Claims 27-29 and 31-36 are withdrawn.

### ***Claim Objections***

5. Claim 37 is objected to because of the following informalities: the preamble of claim 37 relates to a four layer composite, whereas the element identifying numbers improperly also relate to the structure in five layer composite. It should be noted that at line 1 the preamble "A process for the production of a four layer composite" is interpreted as "a process of making a composite consists four layers". Additionally, at second last line, please insert the term "plastic" before "layer (4, 24)", so as to clarify the antecedent basis. Appropriate correction is required.

### ***Rejection Based on Prior Art***

6. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Duncan [US 4626460], and evidenced by Janssen et al. [US 6045922].

Duncan's invention relates to a coextruded label stock. The label stock comprises: (a) a facing layer comprising a polyolefin film and a pressure sensitive adhesive coating (layer) to the lower surface thereof; and (b) a release layer comprising a polyolefin film and a release agent component applied as a coating (layer) to the upper surface thereof. The lower surface of facing layer (a) being peelably affixed to the upper surface of said release layer (b) [abstract]. The release agent can be applied to the surface of release layer (b) in a separate operation [col. 6, ll. 35-37]. Common types of release agent include silicones, polyethylene, fluorocarbon, etc. [col. 6, ll. 40-46]. In one embodiment, the facing layer (a) is compounded with a pressure sensitive

adhesive component, and is coextruded with release layer (b) which has been compounded with a release agent [col. 1, ll. 62-65]. The facing layer (a) can be a laminate of two thermoplastic film, such as laminating to a biaxially oriented polymer film to impart desired appearance [col. 2, ll. 13-20].

For claim 37, Duncan is silent about the process step of “providing the first web and the second web simultaneously in a spaced apart-position; and extruding the adhesive layer and the plastic layer with the release properties between the two webs”. However, Duncan teaches a label stock embodiment comprising four layers of polyolefin film/adhesive/release agent/polyolefin film, which reads on the first web/adhesive layer/releasable plastic layer/second web of the claimed invention. Further, Duncan teaches that 1) the releasable layer and the adhesive layer can be coextruded, 2) the facing layer (a) can be a laminate of two thermoplastic films, 3) the release agent can be applied to the surface of release layer (b) in a separate operation, and 4), the examiner takes Official notice that simultaneous extrusion and lamination with outer layers are common and well known for forming integrated multilayer structure, it would have been obvious to one of ordinary skill in the art to modify Duncan’s process steps to make the four layer laminate of the claimed invention by “providing the first web and the second web simultaneously in a spaced apart-position; and extruding the adhesive layer and the plastic layer with the release properties between the two webs”, because the selection of a known equivalent material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07. Furthermore, as evidenced by Jassen [col. 6, ll. 31-56]:

“The adhesive articles ... can be prepared by a variety of techniques. For example, the adhesive can be extruded onto a preformed backing or the extruded adhesive and the

preformed backing can be nipped together ... Alternatively, the adhesive articles can be prepared by laminating a preformed film of the pressure sensitive adhesive to a preformed backing using heat and pressure as needed to ensure a good bond between the adhesive and the backing ... However, the most preferred approach is coextrusion of the different layers of the adhesive article such as coextruding the pressure sensitive adhesive, the backing and a low adhesion backsize through either a feedblock die or a multimanifold die. Combinations of these different manufacturing techniques may also be used such as coextruding the backing and the low adhesion backsize and then laminating ... the pressure sensitive adhesive.”

Techniques of lamination and coextrusion are known to be equivalent and combined for forming a multilayer adhesive article to one of ordinary skill in the art.

### *Conclusion*

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VICTOR S. CHANG whose telephone number is (571)272-1474. The examiner can normally be reached on 7:00 am - 5:00 pm, Tuesday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Victor S Chang/  
Primary Examiner, Art Unit 1794